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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/791,435 | 03/02/2004 | Andreas Weber | 15436.218.1 | 5414 |

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| EXAMINER | |
|---|---|
| SONG, SARAH U | |
| **ART UNIT** | **PAPER NUMBER** |
| 2874 | |

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/791,435 | WEBER, ANDREAS | |
| | Examiner | Art Unit | |
| | Sarah Song | 2874 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1,5,6,9,11,16,18 and 24 is/are rejected.

7)☒ Claim(s) 2-4,7,8,10,12-15,17,19-23 and 25 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 02 March 2004 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 0704.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The prior art documents submitted by the applicant in the Information Disclosure Statement filed on July 19, 2004 have all been considered and made of record (note the attached copy of form PTO-1449).

### *Drawings*

2. Figure 5B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 5, 6, 9, 11, 16, 18 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilliland et al. (U.S. Patent 6,554,492).**

5. Regarding claim 1, Gilliland et al. discloses a connector that electrically connects an optoelectronic transceiver module and a communication device (column 2, line 62 through column 3, line 24), the connector comprising:

- a first plurality of pads (including pin # 12, 13, 18 and 19) that are used to communicate with a first receiver 31 and a first transmitter 32 of the optoelectronic transceiver module;
- a second plurality of pads (including pin # 4, 5 and 6) used to communicate with the communications device (host system); and
- a third plurality of pads (including pin # 3, 8 and 17) selectively operable to communicate (column 5, lines 8-9 and column 6, lines 29-47).

The claims further recites functional limitations "for bi-directional communication", " for unidirectional communication", and "to communicate with a second receiver and a second transmitter when used to connect the optoelectronic transceiver module to a communications device that is configured for bi-directional communications". Regarding the functional limitations, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus form a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987) and MPEP 2114.

6. Regarding claims 5 and 6, at least two (pin # 18 and 19) of the first plurality of pads communicate with said first transmitter 32 of said optoelectronic transceiver, and at least two (pin # 12 and 13) of said first plurality of pads communicate with said first receiver 31 of said optoelectronic transceiver.

7. Regarding claim 9, the sum of the first plurality, the second plurality and the third plurality equals twenty (see Figure 6).

8. Regarding claim 11, Gilliland et al. discloses a connector that electrically connects an optical transceiver module and a communications device (column 2, line 62 through column 3, line 24), the connector comprising:

- a first plurality of pads (including pin # 12, 13, 18 and 19) that are used to communicate with a receiver 31 and a transmitter 32 of the optical transceiver module;
- a second plurality of pads (including pin # 4, 5 and 6) used to communicate with the communications device; and
- a third plurality of pads (including pin # 3, 8 and 17) that are idle but that can be used to communicate (column 5, lines 8-9 and column 6, lines 29-47).

The claims further recites functional limitations "for unidirectional communication", " for bi-directional communication", and "to communicate with a second receiver and a second transmitter when used to connect an optical transceiver module configured for bi-directional communication to the communications device". Regarding the functional limitations, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus form a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987) and MPEP 2114.

9. Regarding claim 16, the sum of the first plurality, the second plurality and the third plurality equals twenty.

10. Regarding claim 18, Gilliland et al. discloses an optoelectronic transceiver assembly comprising: an optical transceiver module, a communications device that communicates electrically with the optical transceiver module, and a connector that electrically connects the optical transceiver module and the communications device (column 2, line 62 through column 3, line 24), wherein the connector includes:

- a first set of pads (including pin # 12, 13, 18 and 19) that are used to communicate with a first receiver 31 and a first transmitter 32 of the optical transceiver module; and
- a second set of pads (including pin # 3, 8 and 17) that are idle but can be used to communicate.

The claims further recites functional limitations for "providing backwards compatibility between a bi-directional component and a legacy unidirectional component", "wherein one of the optical transceiver module and the communications device is configured for bi-directional communication and the other of the optical transceiver module and the communications device is configured only for unidirectional communication", and "to communicate with a second receiver and a second transmitter when used to connect an optical transceiver module and a communications device that are both configured for bi-directional communication". Regarding the functional limitations, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus form a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987) and MPEP 2114.

11. Regarding claim 24, the sum of the first set and the set equals twenty.

***Allowable Subject Matter***

12. Claims 2-4, 7, 8, 10, 12-15, 17, 19-23 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 2, 4, 12 and 19, Gilliland discloses a communication device to receive a GBIC module but fails to disclose or suggest a communication device configured to receive standard form factor pluggable (SFP) modules or 10 Gigabit standard form factor pluggable (XFP) modules. There is no suggestion or motivation in the prior art of record to modify the communication device of Gilliland et al. to receive standard form factor pluggable (SFP) modules or 10 Gigabit standard form factor pluggable (XFP) modules without impermissible hindsight.

14. Claims 3, 13 and 20 would be allowable as depending from claims 2, 12 and 19, respectively.

15. Regarding claim 21, there is no suggestion or motivation in the prior art of record to conform the first pads/pins of Gilliland et al. to SFP standards since Gilliland et al. is a GBIC module.

16. Regarding claims 7, 8, 14, 15, 22 and 23, Gilliland et al. fails to disclose or suggest a second transmitter and a second receiver of the optoelectronic transceiver.

17. Regarding claims 10, 17 and 25, Gilliland et al. fails to disclose or suggest a sum of the pins equaling thirty.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Song whose telephone number is 571-272-2359. The examiner can normally be reached on M-Th 7:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on 571-272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sarah Song
Patent Examiner
Group Art Unit 2874